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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,711	07/08/2003	Yeong-Seop Lee	5000-1-291	9441

33942 7590 10/27/2005

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EXAMINER	
HOFFMANN, JOHN M	
ART UNIT	**PAPER NUMBER**
1731	

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/615,711	LEE ET AL.	
	Examiner	Art Unit	
	John Hoffmann	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner could find no support for the newly claimed cooling parts selectively closing at a predetermined speed, or that the flow is in a circumferential direction and directed toward the surface of the fiber – either explicit or implicit. This is deemed to be a prima facie showing on failure to comply with the requirement. The burden is now on Applicant to show the requirement is complied with, or to amend the claims so that they comply.

Whereas page 9, lines 9-12 refer to circumferential direction and directed to the surface of the optical fiber, there is no indication that it is "a flow of the turbulence generator" which is so directed. As indicated below, Examiner does not understand what is meant by the claim language, thus it is presumed that since one cannot understand what is meant by the claim language, that it not disclosed in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At line 6 of claim 1 "predetermined" (speed) and "selectively" (closing) read on a nebulous mental steps conducted prior to the manipulative steps of the claimed process, hence rendering the present process claim unclear in meaning in scope. If applicant wishes to patent detail controls over the recited process, the process steps must be positively recited. See *Seagram & Sons Inc. vs Marzall, 84 USPQ 180*.

In other words: if a process has a speed, one would have to read a person's mind to determine whether or not the speed was predetermined one, or a non-predetermined speed.

It is not understood what is meant by the flow being in a circumferential direction and toward the surface of the fiber. If the flow is moving circumferentially it is not moving radially, and vice versa.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 8, 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden 4966615 in view of Sapsford 5568728.

See the prior Office action for the manner in which the art is combined.

As to the new closing step – such is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed

invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Presently, the intended does not result in a structural difference – because one can close things at any speed one wishes.

As to the new flow limitations: See figure 2 of Linden which shows the gas moves toward the fiber at the orifices 20. As to the flow being in a circumferential direction – the gas moves in a direction opposite to the direction the circumference moves. However, such directions are intended use limitations. Clearly the direction of fiber and gas input are intended use. One looking only at the Linden device would not be able to ascertain what direction the fiber/circumference travels or the direction the gas travels.

Alternatively, it is clear that the Sapsford device uses cyclonic gas (i.e. moving in a circumferential manner). The gas will also move towards the fiber whenever it moves from one chamber to the next. The gas has to go through the narrow opening between chambers, which requires the gas to move towards the opening. It would have been obvious to use the Sapsford cyclonic chambers for the reason Sapsford discloses at col 2, lines 4-54.

Claims 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden 4966615 in view of Sapsford 5568728 as applied to claim 1 above, and further in view of Hisashi (jp6219789).

See the prior Office action for the manner in which Hisashi is applied to the other references.

Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linden 4966615 in view of Sapsford 5568728 as applied to claim 1 above, and further in view of Ghani (2003/0205066)

See the prior Office action for the manner in which Ghani is applied to the other references.

Response to Arguments

Applicant's arguments filed 12 August 2005 have been fully considered but they are not persuasive.

AS to the argument that the prior art does not have closing at a predetermined speed. As indicated above, speed and closing are method of use limitations which do not impart any structural limitations to the claims.

IT is also argued that the prior art does not teach the circumferential flow that is directed toward the surface of the fiber. Examiner disagrees: Going by the plain meaning of the terms, the prior art does have the required flow – see rejection above. So, perhaps, using some non-plain meaning the prior art might not meet the claimed limitations. However, Applicant has not pointed out anything which yields a special meaning to the claim limitation which defines over the prior art. Examiner has never

heard of a "circumferential direction" before. A circumference is generally just a circle, and a circle had no direction – or else it has many directions.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10-25-05

John Hoffmann
Primary Examiner
Art Unit 1731

jmh